

REMARKS

Claims 1-4 remain pending in the above-identified application with claims 1-2 standing rejected and claims 3-4 being withdrawn from consideration due to an earlier Restriction Requirement.

***Claim Rejections Under 35 USC § 102(b)***

Claims 1-2 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by Yamada et al. (US 4,491,553). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisssimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In response to Applicant's previous reply of January 29, 2004, and the previously filed 37 CFR § 1.132 Declaration of Mr. Satoru NIPPA (filed on April 15, 2003), the Examiner asserts in the outstanding Office Action that Yamada et al. discloses in one embodiment that the PTFE is in the form of aqueous emulsion, the use fibrillatable PTFE in the form of an emulsion using larger amounts of water given that the emulsion contains several tens of % up to 60% PTFE, and a method of mixing aqueous resin emulsion with ALOH where no kneading is utilized (*e.g.*, see page 2, last line to page 3, line 2, and page 3, lines 10-15 and 18-21 of the outstanding office action).

Accordingly, the Examiner argues that the 37 CFR § 1.132 Declaration Mr. Nippa filed April 15, 2003 was not persuasive given that the declaration was only based on a preferred embodiment of Yamada et al.

However, as disclosed in Examples 3-5 of Yamada, even if an aluminum hydroxide is mixed with a resin and PTFE in the form of aqueous emulsion without kneading, a resin composite having an Y/X of 0.1 or less as claimed in the present invention is not obtained.

In order to evidence this fact, Applicants will submit a second 37 CFR § 1.132 Declaration of Mr. Kazuki TAKEMURA.

As described in the declaration to be submitted, a resin composite obtained by a method of mixing an aluminum hydroxide with a resin and PTFE emulsion without kneading, has an Y/X index outside the scope of the present claim (see the following Table 1).

Table 1

	Y/X index	Addition of PTFE emulsion:	Condition under mixing an aluminum hydroxide with a resin:
<b>Experiment 1</b> (currently submitted)	0.197	9 parts* by weight based on the total amount of an aluminum hydroxide and a resin	Non-kneading
<b>Experiment 1</b> (previously submitted)	0.11	0.3 parts by weight based on the total amount of an aluminum hydroxide and a resin	Kneading
<b>Experiment 1</b> (previously submitted)	0.12	None	Kneading
<b>Example 1</b> (original)	0.038	None	Non-kneading

\* Since a PTFE content in the emulsion is 60%, an amount of PTFE is about 5 parts by weight based on total amount of an aluminum hydroxide and a resin.

Further, the Examiner alleges that "When the fibrillatable PTFE is used in larger amounts wherein the emulsion contains larger amounts of water, it would appear that Yamada et al. do disclose resin composite which would inherently possess Y/X index as

presently claimed" (see page 3, lines 16-18 of the outstanding office action).

However, as apparent from the above results, even if the fibrillatable PTFE is used in the large amount, Y/X index does not satisfy the range of the present claims.

In view of the foregoing, it is submitted that neither claim 1 (nor claim 2 that depends from claim 1) is anticipated under 35 USC § 102(b) by Yamada et al. (US 4,491,553).

Accordingly, based upon the above considerations, Applicants respectfully request that the rejection of claims 1 and 2 be withdrawn at present.

#### ***Rejoinder Request***

Upon allowance of claims 1-2, the Examiner is respectfully requested to rejoin method claims 3-4, which ultimately depend from claim 1.

#### **CONCLUSION**

Based upon the remarks submitted herewith the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims are now in condition for allowance.

Appl. No. 09/708,519

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

John W. Bailey, #32,881

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

JWB:enm  
2185-0480P